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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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VEDDER PRICE KAUFMAN & KAMMHOLZ 222 N. LASALLE STREET CHICAGO, IL 60601			STEIN, JULIE E	
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			2688	

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Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 10/685,919	Applicant(s) WELNICK ET AL.	
	Examiner Julie E. Stein, Esq.	Art Unit 2688	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 11-28-05.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-20 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Response to Amendment

1. In view of the claim amendment to claim 13, the claim objection is withdrawn.

Claim Rejections - 35 USC § 112

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. Claims 5, 8-9, 10-13, and 19-20 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

4. Claims 10-13 are rejected because the scope of the claims is indefinite. The claims recite both a memory and then further recite a list of steps performed by processing devices in response to instruction contained on the memory. As the claims appear to recite both a product (the memory) and a process (the steps of storing and performing) the scope of the claims is vague and renders the claims indefinite.

5. In claims 5, 8, 13, and 19, the claim language fails to particularly point out and distinctly claim how during the second more preferred SID acquisition sequence the first more-preferred stored SID element and the second more preferred stored SID element are repeatedly attempted to be acquired but single acquisition attempts are made for the less preferred stored SID elements (claims 5 and 13) or, alternatively repeated attempts are made for at least one more-preferred SID element and single acquisition attempts are made for the plurality of less-preferred stored SID elements (claims 8 and 19).

Claim Rejections - 35 USC § 101

6. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

7. Claims 10-13 are rejected under 35 U.S.C. 101 because they claim multiple classes of statutory subject matter, including a product (a memory) and a process (steps of storing and performing). Under 35 U.S.C. 101 a single statutory class of subject matter must be claimed, therefore, claims 10-13 must be amended in order to claim a single class of statutory subject matter.

Claim Rejections - 35 USC § 102

8. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

9. Claims 1-20 are rejected under 35 U.S.C. 102(b) as being anticipated by U.S. Patent No. 5,734,980 to Hooper et al.

Hooper discloses all the elements of independent claim 1, including a circuit (inherent in view of the steps of Figure 2) operative to acquire a more-preferred stored SID element comprising: memory (column 6, lines 41 to 65) containing a roaming list that includes a plurality of stored SID elements ranked according to an order of preference (column 6, lines 52 to 54) including at least one more-preferred stored SID element and at least one less-preferred stored SID element (column 6, lines 54 to 65,

the more-preferred and less-preferred SID elements are being interpreted to be any SID element that is ranked above or below respectively one another); and logic circuitry, operatively coupled to the memory (inherent in view of the steps of Figure 2), and operative to perform a first more-preferred SID acquisition sequence (Figure 2 and corresponding description of method in column 7, line 39 to column 9, line 45, where the initial search of a first frequency corresponds to a first acquisition sequence or any frequency search may correspond as long as another frequency search is performed afterwards) and then a second more-preferred SID acquisition sequence (column 9, line 46 to column 10, line 65, where each additional search of a frequency corresponds to a repeated acquisition, alternatively any search of two frequencies meet the claim language as the “more-preferred” does not require that it be the home system) that includes repeatedly attempting acquisition of the at least one more-preferred stored SID element during the second more-preferred SID acquisition sequence (Id.).

The rejection of claim 1 is hereby incorporated. Hooper discloses all the elements of independent claim 6, including a wireless device comprising: memory (column 6, lines 41 to 65) containing a roaming list that includes a plurality of stored SID elements ranked according to an order of preference (column 6, lines 52 to 54) including at least one more-preferred stored SID element and at least one less-preferred stored SID element (column 6, lines 54 to 65); a wireless receiver operative to receive transmitted SID information (inherent in view of column 6, lines 41 to 65 and the receiving of SIDs); and logic circuitry, operatively coupled to the memory (inherent in view of the steps of Figure 2), and operative to perform a first more-preferred SID

acquisition sequence (Figure 2 and column 7, line 39 to column 9, line 45, where the initial search of a first frequency corresponds to a first acquisition sequence or see above) and then a second more-preferred SID acquisition sequence (column 9, line 46 to column 10, line 65, where each additional search of a frequency corresponds to a repeated acquisition and see above) that includes repeatedly attempting acquisition of the at least one more-preferred stored SID element during the second more-preferred SID acquisition sequence (Id.).

The rejections of claims 1 and 6 are hereby incorporated. Hooper discloses all the elements of independent claim 8, including a wireless device comprising: memory (column 6, lines 41 to 65) containing a roaming list that includes a plurality of stored SID elements ranked according to an order of preference (column 6, lines 52 to 54) including at least one more-preferred stored SID element and at least one less-preferred stored SID element (column 6, lines 54 to 65 and see above); a wireless receiver operative to receive transmitted SID information (inherent in view of column 6, lines 41 to 65 and the receiving of SIDs); and logic circuitry (see above), operatively coupled to the memory (inherent in view of the steps of Figure 2), and operative to perform a first more-preferred SID acquisition sequence (Figure 2 and column 7, line 39 to column 9, line 45, where the initial search of a first frequency corresponds to a first acquisition sequence or see above) and then a second more-preferred SID acquisition sequence (column 9, line 46 to column 10, line 65 and see above) that includes, during the second more-preferred SID acquisition sequence, repeatedly attempting acquisition of the at least one more-preferred stored SID element and a single acquisition attempt

of each of the plurality of less-preferred stored SID elements not acquired during the first more-preferred SID acquisition sequence (column 9, line 60 to column 10 line 64, as this repeated and single acquisition sequence is not clearly claimed, it is being interpreted that, for example, there may be two frequencies to be searched and if the second frequency has the highest information on the list, then according to Figure 2, it would be selected at step 88, in which case the more-preferred SID element would be repeatedly attempted and a single acquisition attempt would have been made by the previous search for the less-preferred SID in step 90 or 94), wherein attempting acquisition is based on a comparison of the received broadcast SID information with one of the plurality of stored SID elements (column 9, lines 1 to 11), and wherein the second more-preferred SID acquisition sequence is again performed if acquisition of the plurality of stored SID elements in the roaming list is unavailable (column 9, line 46 to column 10, line 65 discloses the repeat of the frequency scanning and identification of the preferred systems and column 10, line 65 to column 11, line 13, repeats the entire scanning, for example, when a certain time limit has expired).

The rejections of claims 1, 6, and 8 are hereby incorporated. Hooper discloses all the elements of independent claim 10, including a memory containing instructions executable by one or more processing devices that causes the one or more processing devices (see above) to: store a roaming list that includes a plurality of stored SID elements ranked according to an order of preference (see above) including at least one more-preferred stored SID element and at least one less-preferred stored SID element (see above); and perform a first more-preferred SID acquisition sequence and then a

second more-preferred SID acquisition sequence that includes repeatedly attempting acquisition of the at least one more-preferred stored SID element during the second more-preferred SID acquisition sequence (see above).

The rejections of claim 1, 6, 8, and 10 are hereby incorporated. Hooper discloses all the steps of independent claim 14, including a method for acquiring a more-preferred stored SID element in a wireless device (see above), the method comprising: storing a roaming list that includes a plurality of stored SID elements ranked according to an order of preference (see above) including at least one more-preferred stored SID element and at least one less-preferred stored SID element (see above); and performing a first more-preferred SID acquisition sequence and then a second more-preferred SID acquisition sequence that includes repeatedly attempting acquisition of the at least one more-preferred stored SID element during the second more-preferred SID acquisition sequence (see above).

The rejections of claim 1, 6, 8, 10 and 14 are hereby incorporated. Hooper discloses all the steps of independent claim 19, including a method for acquiring a more-preferred stored SID element in a wireless device (see above), the method comprising: storing a roaming list that includes a plurality of stored SID elements ranked according to an order of preference (see above) including at least one more-preferred stored SID element and a plurality of less-preferred stored SID elements (see above); performing a first more-preferred SID acquisition sequence and then a second more-preferred SID acquisition sequence that includes, during the second more-preferred SID acquisition sequence, repeatedly attempting acquisition of the at least one more-

preferred stored SID elements not acquired during the first more-preferred SID acquisition sequence (see above); receiving broadcast SID information wherein attempting acquisition is performed by comparing the received broadcast SID information with one of the plurality of stored SID elements (column 9, lines 1 to 11); and repeatedly performing the second more-preferred SID acquisition sequence if acquisition of the plurality of stored SID elements in the roaming list is unavailable (see above).

Hooper also discloses all the elements of claims 2, 7, and 11, including wherein the logic circuitry is operative to attempt acquisition of the at least one less-preferred stored SID element as part of performing the second more-preferred SID acquisition sequence. See, column 9, lines 12 to 28 and Figure 2.

Hooper also discloses all the elements/steps of claims 3, 12, and 17, including wherein the logic circuitry is operative to perform the second more-preferred SID acquisition sequence if the more-preferred stored SID element is not acquired during the first more-preferred SID acquisition sequence. See, column 10, line 65 to column 11, line 13 and Figure 2.

Hooper also discloses all the elements of claim 4, including, wherein the logic circuitry is operative to attempt acquisition by comparing received broadcast SID information with one of the plurality of stored SID elements ranked according to an order of preference including at least one more-preferred stored SID element and at least one less-preferred stored SID element. See, column 9, lines 1 to 11 and claim 1.

Hooper also discloses all the elements of claims 5 and 13, including wherein the roaming list includes a (storing) first more-preferred stored SID element, (storing) a second more-preferred stored SID element, and a plurality of less preferred SID elements wherein logic circuitry is operative to perform the second more-preferred SID acquisition sequence, that includes repeatedly attempting acquisition of the first more-preferred stored SID element, repeatedly attempting acquisition of the second more-preferred stored SID element and a single acquisition attempt of each of the at least one less-preferred stored SID element. See column 9, line 46 to column 10, line 65 and Figure 2, for example, if two frequencies are searched and the second frequency is determined and stored at step 92 and there are no further frequencies to search then repeated acquisition of a first and a second more-preferred SID have been done at steps 86 and 90 and single attempted acquisitions have been attempted in step 94 for the other stored SIDs for the first frequency scanned.

Hooper also discloses all the elements of claim 9, including the logic circuitry camps on at least one less-preferred stored SID element if acquisition on the at least one less-preferred stored SID element is available (column 10, lines 47 to 64) and if acquisition on the at least one more-preferred store SID element is unavailable (Id.), and wherein the logic circuitry camps on the at least one more-preferred SID stored element if the at least one more-preferred stored SID element is acquired at any time (column 10, line 65 to column 11 line 13).

Hooper discloses all the steps of claim 15, including, receiving broadcast SID information, wherein attempting acquisition is based on comparing the received

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broadcast SID information with one of the plurality of stored SID elements. See, column 9, lines 1 to 11.

Hooper also discloses all the steps of claim 18, including attempting acquisition of the at least one less-preferred stored SID element as part of performing the second more-preferred SID acquisition sequence. See, column 9, lines 12 to 28.

Hooper also discloses all the elements of claim 20, including camping on the at least one more-preferred stored SID element if acquisition of the at least one more-preferred stored SID element is available (column 9, lines 1 to 11); and camping on the at least one less-preferred stored SID element if acquisition of the at least one less-preferred stored SID element is available and if acquisition of the at least one more-preferred stored SID element is unavailable (column 10, lines 47 to 64).

Hooper also discloses all the elements of claim 16. See the rejection of claims 9 and 20.

Response to Amendment

10. In view of Applicants' arguments regarding the 35 U.S.C. 112 2nd paragraph rejections of claims 1-9 regarding the use of "operative" and the Examiner's review of the "The American Heritage College Dictionary," the rejection of these claims has been withdrawn as the definition of "operative" when used as an adjective (and adverb) includes "operating" and thus the claims appear to include positive language and not just the possibility of the circuits and devices having the claimed configurations and requirements.

11. The Examiner also notes that claims 5 and 13, which were previously objected to, have now been rejected under both 35 U.S.C. 112 and the prior art.

12. Applicant's arguments with respect to claims 1-20 have been considered but are moot in view of the new ground(s) of rejection.

13. However, in response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., home system or "most" preferred-SID or system) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

Conclusion

14. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. U.S. Patent No. 6,625,451 to La Medica, Jr. et al. teaches a system for selecting a preferred SID.


Any inquiry concerning this communication or earlier communications from the examiner should be directed to Julie E. Stein, Esq. whose telephone number is (571) 272-7897. The examiner can normally be reached on M-F (8:30 am-5:00 pm).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, George Eng can be reached on (571) 272-7495. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

JES


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